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09/515,272	02/29/2000	David B. Kinder	INTL-0315-US (P7998)	1987
21906	7590	08/22/2006	EXAMINER	
TROP PRUNER & HU, PC 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			SHELEHEDA, JAMES R	
		ART UNIT	PAPER NUMBER	
		2623		

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Technology Center 2600

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/515,272

Filing Date: February 29, 2000

Appellant(s): KINDER ET AL.

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Kinder et al.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 06/06/06 appealing from the Office action  
mailed 11/28/05.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

**NEW GROUND(S) OF REJECTION**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” (Official Gazette notice of 22 November 2005), Annex IV.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claim 12 recites “an article comprising a medium *for* storing instructions that, *if executed*” which does not impart functionality to a computer or computing device, and is thus considered nonfunctional descriptive material. Such nonfunctional descriptive material, in the absence of a functional interrelationship with a computer, does not constitute a statutory process, machine, manufacture or composition of matter and is thus non-statutory per se.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,604,542	Dedrick	02-1997
6,057,872	Candelore	05-2000

PNG (Portable Network Graphics) Specification, Version 1.0, (05-1997).

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 9, 12-15 and 19-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick in view of PNG Specification Version 1.0. This rejection is set forth in a prior Office Action, mailed on November 11<sup>th</sup>, 2005.

Claims 6, 10-11, 17-18 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick and the PNG Specification Version 1.0, and further in view of Candelore. This rejection is set forth in a prior Office Action, mailed on November 11<sup>th</sup>, 2005.

Claim 12 stands rejected under 35 U.S.C. 101 as being directed towards unpatentable subject matter. This rejection is a new ground of rejection.

### **(10) Response to Argument**

- a. Rejection under 35 U.S.C. 103(a) of claims 1-3, 9, 12-15 and 19-20 over Dedrick in view of PNG Specification Version 1.0.

Firstly, in response to appellant's argument on page 10, that the PNG specification does not disclose displaying those portions *earned* by viewing, it is noted that none of the current claims require any sort of "earning" whatsoever. The claim language merely requires that the portions displayed be dependent upon the time spent viewing video content. Neither Dedrick nor the PNG specification were relied upon to disclose *earning*, as it is not required.

Dedrick was relied upon to disclose transmitting video content with a viewer incentive image (column 3, lines 16-22 and column 4, lines 7-11), wherein the viewer incentive image is transmitted as partial, incomplete portions (as individual packets making up the total image are transmitted through the VBI of the video channel; column 4, lines 7-15). The portions of the image are then accumulated over time (as the individual packets are individually downloaded upon the full advertisement is received; column 4, lines 7-15). Furthermore, the portions clearly accumulate dependent upon the time viewing the video signal, as the portions are specifically transmitted with the video signal in the VBI (column 4, lines 7-15). Thus, for example, if the viewer incentive required one minute to be downloaded through the VBI, the viewer would have to be tuned to the channel for at least one minute to receive the image.

While Dedrick discloses wherein the image is downloaded and then fully displayed (column 3, lines 23-37 and column 4, lines 7-19), he fails to explicitly disclose that incomplete portions of the image can be displayed without displaying the full image.

It was the PNG specification which was then relied upon to disclose wherein an image can be progressively displayed as *it is received over a communications link* (see Section 1, Introduction, Progressive Display). This allows received images to be displayed to "fade in" over time by initially displaying a low-resolution image very quickly and then the addition of more details as they are received (see Section 1, Introduction, Progressive Display and

Section 2.6, Interlaced Data Order). This provides the recognized benefit of giving the user a meaningful display much more rapidly (see Section 2.6, Interlaced Data Order).

Secondly, on pages 10 and 11, appellant argues that the reference does not teach progressively displaying portions of the incentive image based on time spent viewing the streaming video.

In response, as indicated above, Dedrick specifically discloses wherein the viewer incentive is received over time, based on time spent viewing the video, *since the incentive is transmitted with the video* (column 4, lines 7-19). Furthermore, Dedrick even states that the viewer incentive can be displayed *with* the video on the *same* monitor (column 3, lines 34-37). The *receipt* of the viewer incentive, which is downloaded as individual packets through the VBI, is dependent upon the time spent viewing the video, as the packets are downloaded, over time, as the viewer watches the video (column 3, lines 16-37 and column 4, lines 7-19). Thus, while Dedrick clearly discloses receiving incomplete portions of the incentive image (column 3, lines 16-37 and column 4, lines 7-19) and that the viewer incentive is displayed to the user (displaying the full advertisement; column 3, lines 33-37 and column 4, lines 7-19), he merely fails to disclose that incomplete portions of the viewer incentive are displayed. It was the PNG specification which was then relied upon to disclose displaying portions of an image, as their received, and the benefit therein.

Thirdly, on page 11, appellant argues that a reference which teaches increasing the rapidity of overall image display, necessarily teaches away from the claimed invention, as requiring that the earned portion be displayed first most certainly delays the rapidity with which the overall image would be presented.

In response, it is once again noted that “earning” portions is not required by any of the current claims. The claims merely require that the amount of display image portions be dependent upon time spent viewing the video. The combination of Dedrick and the PNG specification clearly meet these limitations, as shown above.

Finally, on page 11, appellant argues that neither reference gives any reason why one would display first the earned portion of less than all of the image.

In response, it is once again noted that “earning” portions is not required by any of the current claims. Furthermore, the claims do not include any requirement for which one particular portion to be displayed first. Thus the argument that an “earned” portion must be displayed first is completely irrelevant. As the combination of Dedrick and the PNG specification would disclose that the first arrived portions would be displayed first, this clearly meets the current claim limitations.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

James Shelehedra  
Patent Examiner  
Art Unit 2623

JS  
August 15<sup>th</sup>, 2006

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

Andrew Faile

Conferees:

Chris Kelley

Chris Grant

  
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